

REMARKS

Claims 19-25 and 39-42 are now pending in the application. The amendments to the claims contained herein are of equivalent scope as originally filed and are being made to simply clarify the scope of applicant's invention. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

The examiner has rejected claims 4-8, 19-25, 29-30, 39 and 41-42 under 35 U.S.C. §103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2002/0178029).

Nutter et al. discloses a system and method to determine the likelihood of obtaining a license for a large number of patents or other intellectual property. ¶0004. The method includes a two level system wherein the first level includes receiving a plurality of input scores for each of a plurality of intellectual properties. The input scores are combined to form a scale value for each of the intellectual properties. The scale values are compared to determine a select group. ¶0022. The second level includes applying a licensability rating to the patents in the initial or select group. ¶0022. The licensability rating is a subjective evaluation made by a group of experts in the technical area of the patent. ¶0026. This information is used to determine a second level score. ¶0022.

Elliot discloses assigning a monetary value to a patent for the purpose of using it as a security interest. Specifically, it deals with a method to determine the

securitizable value of an intellectual property, and whether the owner of intellectual property will be benefited by securitizing the intellectual property. ¶0029.

Regarding claim 19, claim 19 as amended requires a plurality of modules each of the modules having a plurality of value drivers with each of the value drivers having a predetermined weighting factor assigned thereto. Each of the value drivers having a plurality of user-specified variables, with each of the user-specified variables also having a predetermined weighting factor assigned thereto and a processor operative to calculate a score for each of said modules using the user-specified variables. Neither Nutter et al. or Elliot as set forth above discloses the use of multiple a predetermined weighting factors, with weighting factors linked to each of the modules, value drivers and user-specified variables and a processor operative to calculate a score for each of said modules using the user-specified variables. Further, contrary to the examiner's position, neither reference discloses a market module, a cost module, and efficiency module, an impact module and an invention module each of which having a plurality of user-specified variables.

As illustrated in FIG. 1 of applicant's invention, the modules are separate portions of an overall apparatus wherein each module has a separate output. The processor calculates the total and module scores for each opportunity. Elliot addresses an apparatus or method for determining the value of intellectual property; it does not disclose a system by which licensing opportunities are prioritized by assigning a relative calculated value to every opportunity. Accordingly, applicant submits that the combination of Nutter et al. and Elliot fails to render applicant's claimed invention

obvious and respectfully requests allowance of claim 29 and the claims depending therefrom.

Regarding claim 39, claim 39 is a method to prioritize licensing opportunities by assigning a relative calculated value to every opportunity. The method includes providing a plurality of modules, including a market module, a cost module, and efficiency module, an impact module and an invention module. Further, the method includes applying predetermined weighting factors to each of the plurality of value drivers set forth in each of the above modules along with the plurality of user-specified values for each of said value drivers. In addition, a total score is calculated for the opportunity and for the each module by using a predetermined function for each of the user-specified variables. Contrary to the contention of the examiner, the prior art, specifically Nutter et al. and Elliot, does not disclose calculating a total score and module scores for each entered opportunity. Specifically, claim 39 requires calculating a module score for each module based on predetermined weighting factors assigned to each of the plurality of value drivers located in the specific module. Since the prior art does not show this alone or in combination, applicant submits a claim 39 is in condition for allowance and respectfully requests the same.

Regarding claims 41-42, these claims depend from claim 39, which as set forth above, is in condition for allowance. In addition, claim 42 requires use of a predetermined weighted average of the module scores to determine a total score. This element is not shown in the prior art. Accordingly, claims 40-42 are now in condition for allowance.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

The Examiner is invited to telephone the applicant's undersigned attorney at 248-364-0200 if any unresolved matters remain.

Please charge any cost incurred in the filing of this amendment, along with any other costs, to Deposit Account No. 06-1510. If there are insufficient funds in this account, please charge the fees to Deposit Account No. 06-1505.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 364-0200.

Respectfully submitted,

Attorney for Applicant(s)

By: s/Joseph G. Burgess
Joseph G. Burgess
Registration No. 33,362
Attorney for Applicants

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